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20 UNITED STATES DISTRICT COURT

21 NORTHERN DISTRICT OF CALIFORNIA

22 SAN FRANCISCO DIVISION

23 MOBILE TELECOMMUNICATIONS
24 TECHNOLOGIES,

Case No.:

25 Plaintiff,

26 v.

27 SAMSUNG ELECTRONICS CO., LTD.,
28 SAMSUNG ELECTRONICS AMERICA,
INC., SAMSUNG
TELECOMMUNICATIONS AMERICA,
LLC.,

**PLAINTIFF MOBILE
TELECOMMUNICATIONS
TECHNOLOGIES, LLC'S MOTION TO
COMPEL THIRD-PARTY GOOGLE,
INC. TO PRODUCE DOCUMENTS AND
TO MAKE AVAILABLE AN
ADDITIONAL WITNESS AND
REQUEST FOR SANCTIONS
PURSUANT TO FRCP 37**

29 Defendants.

1 Plaintiff Mobile Telecommunications Technologies, LLC (“MTel”) asks this Court to
2 enforce MTel’s Subpoena to Testify at a Deposition and Produce Documents, dated November
3 20, 2015 (hereinafter, “Second Subpoena”). MTel was forced to serve the Second Subpoena
4 after Google Inc. (“Google”) failed to adequately prepare its witness to testify on topics
5 identified in MTel’s First Subpoena dated August 10, 2015 (“First Subpoena”). At that first
6 deposition, Google’s representative testified that the information sought by MTel was outside
7 his knowledge and required the production of source code. MTel served the Second Subpoena
8 specifically identifying the topics on which the Google witness was unable to testify and
9 requested the documents the witnesses identified during the first deposition. Google refused
10 to provide either an additional deponent or the required source code. Google failed to appear
11 at the duly, lawfully, and timely noticed deposition in Sunnyvale, CA on December 18, 2015,
12 but never filed a motion to quash.

13 Google’s non-compliance with the Subpoena is unacceptable because MTel diligently
14 met and conferred with Google on the information sought and the relevance of the
15 information. Moreover, Google’s objection that MTel’s Second Subpoena is unduly
16 burdensome and seeks privileged information is without merit because Google failed to file a
17 motion to quash or a protective order. Google chose to merely object to the Second Subpoena
18 and not appear. MTel therefore asks this Court to compel Google’s compliance with MTel’s
19 Subpoena and sanction Google for its noncompliance.

20 **I. FACTUAL BACKGROUND**

21 MTel served its First Subpoena on Google on August 10, 2015, because Google alone
22 has access to the source code and information about the operation of the Google Cloud
23 Messenger (“GCM”), an application at issue in the *Mobile Telecommunications Technologies,*
24 *LLC v. Samsung Electronics Co., et al.* case (hereinafter, “underlying action”). Declaration of
25 Craig Jepson (hereinafter, “Decl. Jepson”), Exhibit (hereinafter, “Ex.”) 1. Samsung’s mobile
26 phones and tablets that operate using version 2.2 or higher of the Android Operating System
27 are accused of infringing U.S. Patent No. 5,809,428 (“the ’428 Patent”). Decl. Jepson, Ex. 2.
28 These devices employ GCM to receive “push” messages from a network operations center. *Id.*

1 GCM is proprietary to Google. GCM includes a server-side component and a device-side
2 component, termed the “client application.”

3 MTel asserts Claim 4 of the '428 Patent against Samsung. Claim 4 recites three
4 “means for generating” elements:

5 “means for generating, upon receiving a data message, a data
6 acknowledgement message, said data acknowledgement message being transmitted
by said transmitter”

7 “means for generating, upon receiving a probe message, a probe
8 acknowledgement message, said probe acknowledgement message being
transmitted by said transmitter”; and

9 ...

10 “means for generating, upon power restoration to the transmitter, a
11 registration message if a probe message has been received while the transmitter
12 was powered off, said registration message being transmitted by said transmitter”

13 Ex. 3 (U.S. Patent No. 5,809,428 at Col. 9, l. 51 to col. 10, l. 3; *id.* at Col. 10, ll. 7-11).

14 Samsung’s GCM client application that operates on Samsung infringing devices
15 performs these three elements. [REDACTED]

16 [REDACTED] Decl. Jepson, Ex. 4 at
17 88:22-89:6. [REDACTED]

18 [REDACTED] *Id.* [REDACTED]
19 [REDACTED]. *Id.*

20 Topic five of MTel’s First Subpoena requested testimony or written materials on “the
21 process by which a Client App will receive a message from the GCM Connection Servers and
22 what actions the Client App will take in response.” Decl. Jepson, Ex. 1 at 6.

23 Documents produced by Google identify several types of messages the GCM client
24 application receives pursuant to the Google-proprietary protocol, including [REDACTED]

25 [REDACTED]. Decl. Jepson, Ex. 5 at GOOG_MTL_00000663 at 00000665 (identifying [REDACTED]
26 [REDACTED]. When questioned about [REDACTED]

27 [REDACTED] Google testified
28 through its corporate representative, Francisco Nerieri, that [REDACTED]

1 [REDACTED]
2 [REDACTED]
3 [REDACTED]
4 [REDACTED]
5 [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]

12 Decl. Jepson, Ex. 4 at 154:1-20.

13 Following Mr. Nerieri's deposition, counsel for MTel requested an additional
14 deposition by the person most knowledgeable on the GCM client application. Decl. Jepson,
15 Ex. 6. Counsel for Google refused to produce an additional deponent. *Id.*

16 As a result of Mr. Nerieri's testimony and Google's refusal to provide an additional
17 deponent to cure this deficiency, MTel issued its Second Subpoena to Google on November
18 20, 2015. Decl. Jepson, Ex. 7. MTel's Second Subpoena contained only five topics. Decl.
19 Jepson, Ex. 7. In the spirit of cooperation, MTel withdrew its request for Topics 4 and 5.
20 Decl. Jepson, Ex. 8. Thus, at issue in this Motion are only Topics 1-3 and the requested
21 documentation. Each of the three remaining topics seeks information regarding how the
22 Google client application receives, processes, responds, or generates specific types of
23 messages. For example, Topic One specifies [REDACTED]
24 [REDACTED]
25 [REDACTED]
26 [REDACTED]

27 Decl. Jepson, Ex. 7.

28 MTel's Second Subpoena also requested production of two other specific categories of
information: (1) all prior depositions of Mr. Francesco Nerieri regarding Google Cloud

1 Messaging; and (2) source code pertaining to specific functions of the GCM client application.
 2

3 *Id.*

4 On December 2, 2015, counsel for MTel and Google conferred via telephone regarding
 5 MTel's Second Subpoena. Decl. Jepson, Ex. 6. Following this call, counsel for MTel issued
 6 correspondence that summarized the conference and provided additional citations to portions
 7 of the deposition transcript of Mr. Nerieri wherein Mr. Nerieri could not provide testimony or
 8 information on topics included in MTel's Second Subpoena. *Id.*

9 MTel's Second Subpoena requested Google to produce documents by December 11,
 10 2015, and noticed the deposition to occur on December 18, 2015, in Sunnyvale, California.
 11 Decl. Jepson, Ex. 7. On December 11th, the date by which Google was to produce documents,
 12 Google responded to MTel's Second Subpoena by objecting that MTel's noticed topics and
 13 document requests were unduly burdensome, cumulative, and sought privileged information.
 14 Decl. Jepson, Ex. 9, at ¶¶ 4, 5, 8.

15 Despite objecting that MTel's Second Subpoena was unduly burdensome and sought
 16 privileged information, Google did not file a motion to quash or protective order. On
 17 December 17, 2015, counsel for MTel reminded counsel for Google of the location for the
 18 deposition noticed for the following day. Decl. Jepson, Ex. 10. Counsel for Google
 19 responded that it would not appear. *Id.* On December 18, 2015, at approximately 9:15 AM,
 20 counsel for MTel put Google's nonappearance on the record when neither counsel for Google
 21 nor the witness appeared. Decl. Jepson, Ex. 11.

22 **II. LEGAL STANDARD**

23 **A. Revised Rule 45 Provides Procedural Requirements.**

24 Rule 45 of the Federal Rules of Civil Procedure requires a party seeking information
 25 from a non-party to seek a subpoena "from the court where the action is pending."
 26 Fed.R.Civ.P. 45(a)(2)-(3). "Valid attorney-issued subpoenas under Rule 45(a)(3) operate as
 27 enforceable mandates of the court on whose behalf they are served." *Simmons v. Fervent*
 28

1 *Elec. Corp.*, No. 14-CV-1804 ARR MDG, 2014 WL 4285762, at *1 (E.D.N.Y. Aug. 29, 2014)
 2 (citing Advisory Committee Notes, 1991 Amendment to Fed.R.Civ.P. 45).

3 Rule 45(c) specifies that the “place of compliance” for deposition testimony and
 4 production of documents may only occur within 100 miles of where the person resides, is
 5 employed, or regularly transacts business in person. Rule 45(d)(3)(iii)-(iv) *requires* a party
 6 seeking to prevent disclosure due to a belief that the subpoena “requires disclosure of
 7 privileged or other protected matter, if no exception or waiver applies” or “subjects a person to
 8 undue burden” to file a timely motion to quash or modify the subpoena. Fed.R.Civ.P.
 9 45(d)(3)(iii)-(iv) (emphasis added).

10 **B. Motions to Compel Compliance with Rule 45**

11 A party may move for compliance of a subpoena and sanctions under Federal Rule of
 12 Civil Procedure 37. Fed. R. Civ. P. 37 (a) (3). The Local Rules of the Northern District of
 13 California require the party seeking compliance with a Subpoena to “detail the basis for the
 14 party’s contention that it is entitled to the requested discovery and show how the
 15 proportionality and other requirements of Fed.R.Civ.P. 26(b)(2) are satisfied.” *Fujikura Ltd.*
 16 v. *Finisar Corp.*, No. 15MC80110HRLJSC, 2015 WL 5782351, at *3 (N.D. Cal. Oct. 5, 2015)
 17 (citing N.D. Cal. Civ. L.R. 37-2).

18 Although a subpoena *duces tecum* issued under Fed. R. Civ. P. 45 is subject to the
 19 relevance standards of Rule 26, “pre-trial discovery is ordinarily ‘accorded a broad and liberal
 20 treatment.’” *Brown v. Brown*, No. CV 13-03318 SI, 2014 WL 172407, at *2 (N.D. Cal. Jan.
 21 15, 2014) (citing *Shoen v. Shoen*, 5 F.3d 1289, 1292 (9th Cir.1993)).

22 When a party seeks testimony from a corporate entity pursuant to Federal Rule
 23 30(b)(6), “the corporation must produce someone familiar with that subject.” *Reilly v.*
 24 *Natwest Mkts. Grp. Inc.*, 181 F.3d 253, 268 (2d Cir.1999). “To satisfy Rule 30(b)(6), the
 25 corporate deponent has an affirmative duty to make available ‘such number of persons as will’
 26 be able ‘to give complete, knowledgeable and binding answers’ on its behalf.” *Id.* “The
 27 purpose behind designating a witness to represent the corporation is to prevent bandying,
 28 which is the practice of presenting employees for their depositions who disclaim knowledge of

1 the facts known by other individuals within the organization.” *Gulfstream Worldwide Realty,*
 2 *Inc. v. Philips Elec. N. Am. Corp.*, No. 06-1165, 2007 WL 5704041, *5 (D.N.M. Oct. 24,
 3 2007) (internal quotation marks omitted).

4 **III. MTEL’S SECOND SUBPOENA MET ALL PROCEDURAL REQUIREMENTS**

5 Under Rule 45, a subpoena must: (1) “issue from the court where the action is
 6 pending”; (2) be personally delivered to the subpoenaed person; and (3) comply with the 100-
 7 mile rule. *See Fed.R.Civ.P 45(a)(2), 45(b)(1), and 45(c)(1).*

8 The currently pending litigation is before Magistrate Judge Payne of the Eastern
 9 District of Texas, Marshall Division—from where the subpoena issued. Decl. Jepson, Ex. 7.
 10 MTel’s Second Subpoena was personally delivered to Google’s registered process server, Mr.
 11 Joe Abello. Decl. Jepson, Ex. 12. MTel’s Second Subpoena requested Google to produce
 12 both documents and its corporate representative at the offices of Regus Business Center, 640
 13 W. California Ave., Suite 210, Sunnyvale, California 94086—approximately six miles from
 14 Google’s corporate headquarters. Decl. Jepson, Ex. 13. Google never objected that service
 15 was not properly made under Rule 45. Jepson Decl. at ¶ 12.

16 **IV. MTEL’S SUBPOENA SEEKS RELEVANT DISCOVERABLE INFORMATION
 17 AND IS NOT UNDULY BURDENSOME FOR GOOGLE TO PRODUCE**

18 “The scope of discovery through a subpoena is the same as that applicable to Rule 34
 19 and the other discovery rules,’ which in turn is the same as under Rule 26(b).” *Loop AI Labs*
 20 *Inc v. Gatti*, No. 15CV00798HSGDMR, 2015 WL 5522166, at *5 (N.D. Cal. Sept. 18, 2015)
 21 (citing Advisory Committee Notes to 1970 Amendment) (other internal citations omitted).
 22 “Rule 26(b) allows a party to obtain discovery concerning ‘any nonprivileged matter that is
 23 relevant to any party’s claim or defense.’” *Id.* (citing Fed.R.Civ.P. 26(b)(1)). “Relevancy, for
 24 the purposes of discovery, is defined broadly, although it is not without ultimate and necessary
 25 boundaries.” *Id.* (citing *Gonzales v. Google, Inc.*, 234 F.R.D. 674, 679–80 (N.D. Cal.2006)).

26 MTel’s Second Subpoena seeks information that is directly relevant to its assertion of
 27 Claim 4 of the ’428 Patent. The information regarding the operation of the GCM client
 28 application in receiving and processing messages and generating responses to those received
 messages is solely within the possession of Google. Although MTel previously sought this

1 information through corporate testimony of Google, additional discovery is necessary because
2 Google did not adequately prepare its witness to testify on Topic 5 of MTel's First Subpoena.

3 [REDACTED] Decl.
4 [REDACTED]
5 Jepson, Ex. 4, at 154:1-20. Specifically, [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 *Id.* at 154:1-9.

12 Topics 1-3 of MTel's Second Subpoena are limited to the subject matter for which
13 Mr. Nerieri was not able to testify. Topic 1 seeks [REDACTED]
14 [REDACTED]
15 [REDACTED] Decl. Jepson, Ex. 7. Topic 2 seeks [REDACTED]
16 [REDACTED] *Id.* Finally, Topic 3 seeks [REDACTED]
17 [REDACTED]
18 [REDACTED] *Id.* The four message types identified in Topics 1 and 2 are identified in
19 the document included in Topic 3. *See* Decl. Jepson, Ex. 5 (identifying [REDACTED]
20 [REDACTED]). The information MTel seeks
21 through its Second Subpoena is highly relevant because the '428 Patent claim MTel asserts
22 against Samsung claims three "means for generating" elements. Google's documents are
23 silent as to how the client application generates these messages; thus Mr. Nerieri's testimony
24 is needed. MTel's request for source code is equally vital because Mr. Nerieri testified [REDACTED]
25 [REDACTED]
26 [REDACTED] Decl. Jepson, Ex. 4, at 154:1-20.

27 MTel's Second Subpoena is not unduly burdensome nor cumulative. "The question of
28 undue burden on a non-party requires a court to balance the subpoena's benefits and burdens,

1 and ‘calls upon the court to consider whether the information is necessary and available from
 2 any other source.’ *Rembrandt Patent Innovations, v. Apple, Inc.*, No. 1:15-CV-438-RP, 2015
 3 WL 4393581, at *1 (W.D. Tex. July 15, 2015).

4 The parties have met and conferred several times regarding MTel’s subpoenas. MTel
 5 has identified specific portions of Mr. Nerieri’s testimony where Mr. Nerieri could not provide
 6 the information MTel now seeks. MTel’s Second Subpoena requests testimony on only three
 7 related topics; prior deposition transcripts of the witness regarding the same GCM service at
 8 issue here; and production of source code for a specific and defined operation for which
 9 Google’s own witness admits is necessary to review.

10 **V. THE COURT SHOULD AWARD MTEL ITS EXPENSES INCURRED BY
 11 PURSUING ITS SECOND SUBPOENA**

12 A party may recover its expenses, including attorneys’ fees and costs, incurred as a
 13 result of filing a motion to compel under Federal Rule 37(a)(5). “The decision whether to
 14 grant fees and costs is committed to the court’s discretion.” *Sprint Nextel Corp. v. Ace
 15 Wholesale, Inc.*, 2:14-cv-2119, 2015 WL 3649623 at *2 (D. Nev. June 10, 2015) (citing *Yeti
 16 by Molly, Ltd. v. Deckers Outdoor Corp.*, 259 F.3d 1101, 1106 (9th Cir. 1992)).

17 MTel has incurred costs and fees associated with issuing MTel’s Second Subpoena,
 18 pursuing fulfillment of the Second Subpoena in the face of Google’s continued refusal to
 19 produce a witness or documents, and filing this Motion. Decl. Jepson, ¶ 16. For the reasons
 20 stated above in support of MTel’s Motion to Compel, Google’s refusal to meet its obligations
 21 is not substantially justified. *See N.L.R.B. v. Cable Car Advertisers, Inc.*, 319 F.Supp.2d 991,
 22 1001 (N.D. Cal. 2004) (awarding attorney’s fees when party’s reason for failing to produce
 23 documents was not substantially justified when party failed to demonstrate information was
 24 privileged).

25 **VI. CONCLUSION**

26 For the reasons set forth above, plaintiff Mobile Telecommunications Technologies,
 27 LLC respectfully requests the Court to grant its Motion to compel Third-Party Google, Inc. to
 28 Produce Documents and Make Available An Additional Witness. Should the Court grant
 MTel’s Motion, MTel further requests the Court allow MTel to recover its expenses, including

1 attorneys' fees and costs, incurred as a result of filing this motion to compel and otherwise
2 pursuing its Second Subpoena.

3
4 Dated: January 8, 2016

Respectfully submitted,

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